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REMARKS

Claims 1-30 of the application stand rejected. Claims 1, 8, 13, 19 and 26 have been amended herein to more clearly define the scope of the presently claimed invention. Applicant respectfully requests reconsideration of pending Claims 1-30 in light of the remarks herein.

35 U.S.C. § 102

Claims 1-30 stand rejected under 35 U.S.C. § 102 as anticipated by Dennis, U.S. Patent No. 6,641,087 (hereafter "Dennis"). The Examiner submits that Dennis teaches all the elements of independent Claims 1, 8, 13, 19 and 26. Applicant respectfully traverses the rejection.

The Examiner submits that various sections of Dennis disclose all elements of the independent claims. For example, with respect to independent Claims 1, 8, 13, 19 and 26, the Examiner submits that the element of "the second portion comprising a header" is taught by Dennis, 325, Fig. 3. In reality, item 325 in Fig. 3 points to the header of an email message, rather than the header of a mail file. As described in the specification:

"The header 110 may be expressed in any common syntax including, but not limited to, XML, HTML, and numeric offsets. The header 110 links include a link to the start of the email data, a link to the email sender, a link to the email receiver(s), and the like. All the meta-data information 130 is similarly referenced, but not necessarily stored, in the header 110....Following the header 110 is the actual email data 120. The data portion is of variable length."

Specification, Page 4, lines 23-28

Applicant respectfully submits that the "header" as used in the claims differs significantly from the alleged "header" highlighted by the Examiner. Again, the Examiner appears to be correlating the "header" in the claim with the header of an email message, that typically includes the title of an email and the sender and recipient of the email. Applicant respectfully submits that the term "header" as used in the claims is described in the section of the specification above, i.e., a header having links to various information that may be used to monitor changes in the variable meta-data information. Applicant respectfully submits that nothing in the section of Dennis highlighted by the Examiner shows a header, as claimed.

Similarly, the Examiner suggests that Dennis Col. 1, line 65 – Col. 2, line 39, Col. 3, line 3, line 30 – Col. 3, line 3, Col., 6 lines 41-65 and Col 10, lines 47-62 all teach the remaining element of the claim, namely that the information is additionally capable of identifying a location of the electronic mail data within the electronic mail file. Applicant respectfully disagrees.

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First and foremost, Applicant submits that the Examiner has made no more than generalized allegations regarding what the various sections of Dennis disclose. For example, Dennis, Col. 1, line 65 – Col. 2, line 39, reads as follows:

"The present invention provides a computer-implemented method and system for communicating content intended for delivery to a recipient of an electronic mail message having an attached electronic file. The attached electronic file can be accessed in response to an input signal issued by an input device, such as a keyboard or pointing device, that is manipulated by the recipient of the electronic mail message. The identity of a remote server computer, such as a web site on an intranet or the global Internet, can be obtained in response to accessing the attached electronic file. The remote server computer publishes the content intended for communication to the email message recipient. This content can be displayed to the recipient by using the identity to establish a connection with the remote server. By providing the recipient of the electronic mail message with an automated mechanism for viewing the content at this identified remote server computer, the present invention eliminates the need to store this content within the attached file itself.

More particularly described, the present invention supports the communication of electronic content by using an electronic mail message to transport an electronic file attachment having instructions that, when executed by the recipient's computer, enable the recipient to view the electronic content by accessing a server computer identified by the electronic file attachment. In response to an input signal transmitted by a user's manipulation of an input device, the electronic file attachment is accessed by an electronic mail program. This electronic file attachment is typically opened for viewing within the viewing window of a document view program. For one aspect of the invention, the electronic file attachment contains a limited amount of content, such as a text-based instruction message, for viewing by the recipient within the viewing window. For example, a representative instruction message offers the recipient instructions on how to access a larger set of content by launching the electronic file attachment. In response to an input signal for launching the electronic file attachment, a browser program is launched to access content at a remote server computer identified by the attached file. This results in an automated transition from the electronic mail program environment to the browser program environment to support viewing of the content hosted at the remote server computer."

Applicant fails to see how this section discloses any portion of the claimed element of "[a second portion comprising a header with links to information capable of monitoring changes in the variable meta-data information], the information additionally capable of identifying a location of the electronic mail data within the electronic mail file". This section appears to talk about "an electronic file attachments having instructions, that, when executed by the recipient's computer, enable the recipient to view the electronic content by accessing a server computer identified by the electronic file attachment." Applicant's is simply at a loss to understand how this relates to the claimed elements. Additionally, the Examiner is apparently somehow combining the teachings of this section with the teachings in the other highlighted sections of Dennis (Col. 3, line 3, line 30 – Col. 3, line 3, Col., 6 lines 41-65 and Col 10, lines 47-62). Again, Applicant's fail to understand the relevance of these sections and how they relate to the claimed elements. Applicant respectfully submits that by failing to specifically point to each

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section of Dennis and by failing to clearly articulate how the section(s) allegedly read(s) on the claimed elements, the Examiner has failed to establish a *prima facie* case of anticipation. As is well-established, in order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the cited prior art must disclose every limitation of the claims being rejected. Therefore, if even one claim element or limitation is not disclosed by the reference, a *prima facie* case is not established. Additionally, as the Federal Circuit has noted,

“As adapted to *ex parte* procedure, *Graham [v. John Deere Co.]* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.”

In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The Examiner thus has the burden of producing a factual basis for his rejection and for establishing anticipation by identifying how each recited claim element is allegedly disclosed by the cited reference(s). Applicant respectfully submits that the Examiner has failed to establish such a *prima facie* case and has merely provided bare allegations that Dennis anticipates the claims.

Applicant therefore respectfully requests the Examiner to clarify the Examiner's interpretation of these sections of Dennis. Barring that, Applicant maintains that Applicant's own reading of Dennis supports Applicant's position that Dennis does not disclose the claimed elements. Applicant therefore respectfully requests the Examiner to withdraw the 35 U.S.C. § 102 rejection to Claims 1, 8, 13, 19 and 26 and all claims dependent on these independent claims.

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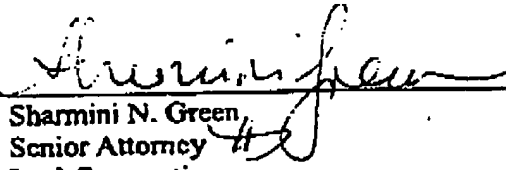
CONCLUSION

Based on the foregoing, Applicant respectfully submits that the applicable objections and rejections have been overcome and that pending Claims 1-30 are in condition for allowance. Applicant therefore respectfully requests an early issuance of a Notice of Allowance in this case. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (714) 669-1261.

If there are any additional charges, please charge Deposit Account No. 50-0221.

Respectfully submitted,

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